



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 2102

John HENDRICKS

Group Art Unit: 3627

Application No.: 09/964,883

Examiner: R. LANEAU

Filed: September 28, 2001

Attorney Docket No.: 026880-00034

For: ELECTRONIC BOOK SELECTION AND DELIVERY SYSTEM HAVING
PURCHASE AND ACCOUNT MANAGEMENT FEATURES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP: AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

September 24, 2007

Sir:

The Applicant requests review of the Final Office Action mailed June 22, 2007, in the above-identified application. This request is not accompanied by an amendment to the currently pending claims, and is filed with a Notice of Appeal.

Claims 10-29 are currently pending in this application. The outstanding Office Action is the sixth and Final Office Action in this application. Thus, this application qualifies for Appeal.

The Office Action rejects claims 10-29 under 35 U.S.C. §103(a) as being unpatentable over Chan (U.S. Patent No. 5,054,984) in view of Wojcik (U.S. Patent No. 5,666,493). The Applicant respectfully submits that the legal and factual basis of the prior art rejections contain clear deficiencies.

I. §103(a) Rejection of Claims 10, 15, 20, and 25

A. Legal Deficiency by Omission of Essential Limitations Needed for *Prima Facie* Rejection

To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.¹

Claims 10, 15, 20, and 25 recite at least the combination of storing identifications of a plurality of electronic books for display on a viewer, associating each of the electronic books with a source, providing the electronic books for purchase by subscribers, and recording an indication of purchases of the electronic books. Claims 10 and 20 further recite associating an amount of each purchase with the source for the corresponding electronic book. The Office Action fails to provide corresponding features for at least the combination of these limitations of claims 10, 15, 20, and 25.

The Office Action references Chan at col. 7, lines 37-58, and Fig. 1, as disclosing the steps of storing identifications of a plurality of electronic books for display on a viewer, associating each of the electronic books with a source, providing the electronic books for purchase by subscribers, and recording an indication of purchases of the electronic books (see Office Action, page 2).

The Applicant respectfully submits that Chan, as referenced, merely discloses a binding line book tracking system. Although the referenced section discloses an “electronic book tracking means or system,” Chan, as referenced, merely discloses a system for electronically tracking the physical location of a hard copy book during the binding process through the use of a code, such as a bar code (see Chan, col. 7, lines 42-46). Thus, Chan’s binding line book

¹ See, e.g., *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), MPEP §2143.03.

tracking system for “hard copy books” fails to correspond to the claimed method for “electronic books.”

In addition, the Office Action acknowledges that Chan fails to disclose or suggest the feature of “associating an amount of each purchase with the source for the corresponding electronic book,” as recited in claims 10 and 20. The Office Action references Wojcik at col. 5, lines 9-12, col. 19, lines 62-64, col. 20, lines 3-13 and 16-19, and Figs. 3 and 40, as curing this deficiency (see Office Action, pages 2-3).

The Applicant respectfully submits that Wojcik merely discloses a system for managing customer orders, and does not cure the deficiencies discussed above. Wojcik fails to disclose or suggest at least the feature of “associating an amount of each purchase with the source for the corresponding electronic book,” as recited in claims 10 and 20. Moreover, there is no mention of an “electronic book” in Wojcik. Thus, Wojcik fails to disclose at least the combination of features recited in claims 10 and 20.

Accordingly, because Chan and Wojcik fail to disclose each and every feature of claims 10, 15, 20, and 25, there is an omission of an essential limitation needed for a *prima facie* rejection of claims 10, 15, 20, and 25, as well as for claims 11-14, 16-19, 21-24, and 26-29, which depend from claims 10, 15, 20, and 25, respectively.

B. Factual Deficiency

As described above, the Office Action points to Chan at col. 7, lines 37-58, and Fig. 1, as disclosing the steps of storing identifications of a plurality of electronic books for display on a viewer, associating each of the electronic books with a source, providing the electronic books for purchase by subscribers, and recording an indication of purchases of the electronic books, as recited in claims 10, 15, 20, and 25; and points to Wojcik at col. 5, lines 9-12, col. 19, lines 62-

64, col. 20, lines 3-13 and 16-19, and Figs. 3 and 40, as disclosing the step of associating an amount of each purchase with the source for the corresponding electronic book, as recited in claims 10 and 20.

As cited, Chan merely discloses a binding line book tracking system and Wojcik merely discloses a system for managing customer orders, and neither Chan nor Wojcik discloses or suggests an “electronic book,” as recited in claims 10, 15, 20, and 25.

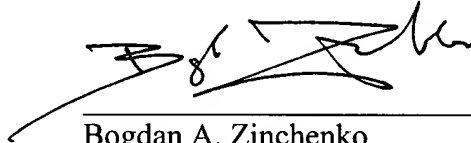
Accordingly, the Office Action’s assertion of Chan’s binding line book tracking system and Wojcik’s system for managing customer orders as a ground for the rejection of claims 10, 15, 20, and 25, as well as dependent claims 11-14, 16-19, 21-24, and 26-29, is improper and should be withdrawn.

II. Conclusion

For at least the reasons discussed above, the Applicant respectfully submits that the Office Action includes legal and factual deficiencies, and thus, claims 10, 15, 20, and 25, as well as their respective dependent claims are patentable over Chan and Wojcik. Accordingly, a favorable decision including the allowance of all pending claims is earnestly solicited.

In the event that this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 026880-00034.

Respectfully submitted,



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